

REMARKS

This is intended as a full and complete response to the Final Office Action dated August 11, 2006, having a shortened statutory period for response set to expire on November 11, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-4, 6, 9-12, and 14-19 remain pending in the application after entry of this response. Claims 7, 13, and 20-21 have been cancelled. Reconsideration of the pending claims is requested for reasons presented herein.

Claim Objections

Claim 7 is objected to under 37 C.F.R. § 1.75 as being of improper dependent form.

Claim 7 has been cancelled. Removal of the objection is requested.

35 U.S.C. § 103

Claims 1-4, 6, 9-12, and 14-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nazzal*, U.S. 6,155,343, in view of *Newman, et al.*, U.S. 5,794,703. The Examiner states that "*Nazzal* does not disclose releasing the first anchor and moving the first anchor to a new position" and that "*Newman* teaches an axial displacement part is positioned between the first anchor and the second anchor...." The Examiner states that because "it would be advantageous to move the tool to different sections of the wellbore it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by *Nazzal* to have an axial displacement part between the two anchors in view of the teachings of *Newman*." Applicant respectfully traverses this rejection.

In order to establish a prima facie case of obviousness based on the prior art, the Examiner must show some "objective teaching in the prior art of that knowledge generally available to one of ordinary skill in the art would lead that individual to

combine the relevant teachings or the references." *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780, 1983 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *Id.* at 1783-84. Moreover, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Id.* at 1784.

The examiner has failed to provide an objective teaching in the prior art that would lead to a combination of the references. *Nazzal* does not disclose two anchors. *Nazzal* discloses one anchor and two stabilizers. The one anchor is for holding the cutting tool at the proper location while cutting. The stabilizers are only used to prevent radial movement of the cutting tool. For example, the specification states "some kind of **anchoring device (not shown)** is then engaged such that the cutting tool 324 is held at the proper level within the structural member 310 while the cutting tool nozzle 32 rotates axially around the inside diameter of the structural member 310 while performing the cut." (Col. 8, ln. 40-44, emphasis added). "The stabilizers 40a-b are then set to ensure minimal radial movement of the tool 20 in the wellbore 22." (col. 6, ln. 27-29). Stabilizers are used to prevent radial movement of the cutting tool and do not perform the same function as anchors which are used to axially and radially fix a portion of the tool. *Nazzal* does not disclose an axial displacement part designed to move the cutting tool axially to cut an axial length.

Newman et al. discloses a wellbore tractor for moving an item through a wellbore by alternatively engaging two slips 123 and 146 on an inner wall 134 of a wellbore. The tractor is for continuous linear movement and is not adapted for moving the item along any path within a work area. In other words, the tractor of *Newman* is merely a form of conveyance tool that has a similar function to the conveyance means 24 (e.g., tubing or wireline) of *Nazzal*. As discussed, the cutting of *Nazzal* takes place after the anchor is set. Therefore it would not have been obvious to use the tractor of *Newman* to steer the cutting tool of *Nazzal* along any path within a work area. Therefore, the references, neither alone nor in combination teach, show, or suggest at least one of the axial displacement part and the rotational part is controllable by the programmable controller

so that the work tool can be steered along any path within a work area, as recited in claims 1, 14, and 15. Further, the references, neither alone nor in combination, teach, show, or suggest directing the work tool with an axial displacement part and a rotational part operably connected to at least one of a first and second anchor, as recited in claim 9. Withdrawal of the rejection is respectfully requested.

Claims 1-4, 6, and 9-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jennings*, U.S. 6,012,526, in view of *Newman, et al.*, 5,794,703.

Regarding 1, 3-4, 14, 15, and 20-21, the Examiner states that because "it would be advantageous to move the tool to different sections of the wellbore it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by *Jennings* to have an axial displacement part between the two anchors in view of the teachings of *Newman*. Applicant respectfully traverses this rejection.

The Examiner states that "*Jennings* does not disclose an axial displacement part between two anchors." *Jennings* discloses a cage 150 containing a cutting tool 116. The cage 150 moves axially and rotationally to position the cutting tool 116. There is no motivation to combine a cutting tool 116 that can move axially with the tractor of *Newman, et al.* The axial displacement of the cutting tool 116 has been provided for by *Newman et al.*; therefore, there is no motivation to combine the tool in *Jennings* with the tool in *Newman et al.*

Further, there is no reference in *Jennings* to an anchor on the milling device 114. Rather, *Jennings* refers to stabilizers. As discussed above, stabilizers are not the same as anchors. Stabilizers are used to prevent radial movement of the cutting tool and do not perform the same function as anchors which are used to axially and radially fix a portion of the tool.

Further, *Jennings* discloses apparatuses and methods for completion of junctions between primary and lateral wellbores and for cutting windows in a wellbore casing. There is no motivation to combine a tool for moving an apparatus in a substantially non-vertical lateral wellbore with a tool used in a vertical wellbore to cut a window or entry into the lateral wellbore. Thus, there is no motivation to combine *Newman et al.* with *Jennings*. Therefore, the references, neither alone nor in combination teach, show, or

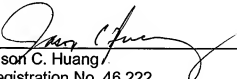
suggest at least one of the axial displacement part and the rotational part is controllable by the programmable controller so that the work tool can be steered along any path within a work area, as recited in claims 1, 14, and 15. Further, the references, neither alone nor in combination, teach, show, or suggest directing the work tool with an axial displacement part and a rotational part operably connected to at least one of a first and second anchor, as recited in claim 9. Withdrawal of the rejection is respectfully requested.

Conclusion

Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Respectfully submitted,



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